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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/490,666	01/24/2000	Robert Alvin Mohror	1203	7465

27310 7590 12/28/2001

PIONEER HI-BRED INTERNATIONAL INC.  
7100 N.W. 62ND AVENUE  
P.O. BOX 1000  
JOHNSTON, IA 50131

EXAMINER

FOX, DAVID T

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 12/28/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/485,666

Applicant(s)

Mehror

Examiner

FOX

Group Art Unit

1638

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE — 3 — MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 10/10/01
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-59 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 14, 17, 19, 29, 33, 36, 46, 48-50 is/are rejected.
- ☒ Claim(s) 1-13, 15, 16, 18, 21-32, 34-35, 37-45, 47 + 51 is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 6, 21, 25, 37 and 40, and dependents, remain objected to for their inclusion of blank lines.

The amendments of 10 October 2001 and accompanying arguments have overcome the claim errors and outstanding rejections under 35 USC 112, second paragraph and 35 USC 103.

Claims 19-20 and 48-49 (newly amended), and new claim 50, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 19-20 and 48-49 are indefinite in their recitation of "the single gene conversions of claim 18 [or 47]" since claims 18 and 47 are drawn to maize plants, not single gene conversions.

The following amendments would obviate this rejection:

In claims 19-20, line 1, insert --of claim 18,-- after "thereof,".

In claims 19-20, line 2, delete "of claim 18".

In claims 48-49, line 1, insert --of claim 47,-- after "thereof,".

In claims 48-49, line 2, delete "of claim 47".

Claim 50 is indefinite in its recitation of "seed further comprises...male sterility" since plants but not seeds exhibit male sterility. The following amendment would obviate this rejection:

Replace "seed of claim 1 wherein said seed" with --plant of claim 3 wherein said plant--.

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Claims 14, 17, 33, 36 and 46 remain rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Arthur (U.S. Patent 5,723,739), as stated in the last office action.

Claims 1-13, 15, 16, 18-32, 34, 35, 37-45 and 47-51 are deemed free of the prior art, given the failure of the prior art to teach or suggest a maize plant with the unique complete genetic component and unique combination of morphological and physiological traits of PH48V, as argued on page 12 of the amendment of 10 October 2001.

No claim is allowed.

Applicant's arguments filed 10 October 2001, insofar as they pertain to the rejections above, have been fully considered but they are not persuasive.

Applicant urges that the rejection under 35 USC 102 or 103 in the alternative is improper, given the failure of the prior art to teach or suggest a corn plant with the same genotype and combination of morphological and physiological characteristics as PH48V, wherein PH48V also exhibits unique combining ability, as evaluated by Chapter 19 of Fehr appended to the amendment of 10 October 2001 as Exhibit A. Applicant also urges that the genetic profile of PH48V can be evaluated by molecular techniques such as RFLP.

The Examiner maintains that the remaining rejected claims are not drawn to a plant possessing all of the morphological and physiological characteristics of PH48V or a plant comprising the unique genetic profile of PH48V. Instead, the claims are merely drawn to a corn plant exhibiting only two traits which are expressed to the same degree as they are expressed in

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PH48V. As noted by Applicants on page 12 of the amendment of 10 October 2001, what is patentable about PH48V is its unique combination of genetic and morphological characteristics as a whole, including its combining ability. PH48V does not express individual traits, or a combination of two or a few traits, at a level or degree that has not been observed in other maize plants. Since the rejected claims do not specify the identity of the other parent involved in the multiple crosses with PH48V over a multitude of generations, wherein PH48V might be utilized only in the first generation cross, followed by outcrossing with non-PH48V parents in every subsequent cross, the claims read on a corn plant that retains very little if any PH48V genetic material.

Regarding the molecular techniques, the Examiner maintains that no molecular profiles of the PH48V parent have been disclosed, and that no genetic markers unique to PH48V, which would be maintained in progeny having as little as 2% of PH48V genetic material (which would occur following the fifth generation of outcrossing), have been disclosed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

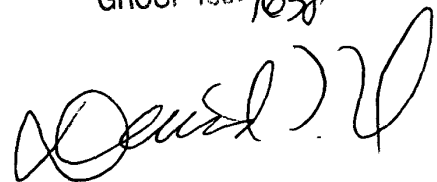
Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (703) 308-0280. The examiner can normally be reached on Monday through Friday from 10:30AM to 7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached on (703) 306-3218. The fax phone number for this Group is (703) 872-9306. The after final fax phone number is (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

December 21, 2001

DAVID T. FOX  
PRIMARY EXAMINER  
GROUP 1638

A handwritten signature in black ink, appearing to read "David T. Fox", is written over the typed name and title.